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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/663,276	09/16/2003	Timothy Patrick Cannella	1622(SURA)	5287
30010	7590	09/19/2006	EXAMINER	
AUZVILLE JACKSON, JR. 8652 RIO GRANDE ROAD RICHMOND, VA 23229			ALLEN, WILLIAM J	
			ART UNIT	PAPER NUMBER
			3625	
DATE MAILED: 09/19/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/663,276	Applicant(s) CANNELLA ET AL.	
	Examiner William J. Allen	Art Unit 3625	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 August 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:    .
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Prosecution Summary History*

Claims 1-20 are pending and rejected as set forth below.

### *Response to Arguments*

Applicant's arguments filed 8/14/2006 have been fully considered but they are not persuasive.

**Regarding the rejection of claims 11-20 under 35 USC 101**, Applicant has amended claim 11 to include storing and executing the electronic publication, contending that the amendment to claim 11 overcomes this rejection. The Examiner, however, disagrees. The electronic publication, in accordance with the specification, is simply a mere arrangement of data such as categorized buyer requirements and information fields such as name, description, etc. The electronic publication has no functional interrelation to the computer system itself. In other words, the electronic publication is a mere presentation of data that has been stored. Simply reciting in the claim language that the publication is "stored and executed" does not make it statutory subject matter. Thereby, the rejection of claims 11-20 under 35 USC 101 is maintained.

**Regarding Applicant's arguments on pages 7-9 concerning independent claims 1 and 11**, Applicant contests that 892u fails to disclose "publishing a buyer's requirements in an electronic publication that provides vendors with information needed to do business with the buyer". Applicant also contends that 892u fails to teach categorizing a buyer's requirements including one or more items required by the buyer.

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892u distinctly shows posting, under a "sale/wanted" section ads by buyers requesting goods or services, allowing a respondent or "vendor" to engage in communications with the buyer to supply a certain good or service requested (see at least: Page 1 B, and 7-8). Additionally, the listings are categorized such as on page 1 (labeled a-i).

Applicant also contends that 892u fails to show "posting all forms and information necessary for the vendor to do business in a format that allows editing of the forms by the vendor". Again the Examiner disagrees for at least the following: As cited in the previous action, all the information that that is necessary is posted in the listing, with the listings including requests for information, quotes, proposals, etc. (see Pages 1, 7, and 8; Pages 7 and 8 show a request for a proposal). The hyperlinked user name is posted at the top of the page and provides the respondent/vendor to the only form necessary to conduct business with the buyer (see Page 9). The email form allows for data entry into fields E and F (i.e. the email form *allows editing of the forms by the vendors and submission of an edited form to the buyer electronically*).

Lastly, Applicant contests that 892u fails to show "creating a registration section that allows vendors to register with the buyer, wherein after registration the vendors can receive electronic notification concerning any item specified". The Examiner notes that by submitting a response to the buyer, the respondent/vendor *registers* with the buyer. Subsequently, vendors can receive electronic notifications concerning any item specified by the vendors during registration via reply emails (see at least: Pages 7-9).

The Examiner asserts that 892u teaches all of the limitations of claims 1 and 11 as illustrated by the previous action and the response above. The rejection under 35 USC 102(b) is thereby maintained.

Additionally, the Examiner notes that Applicant has merely alleged that 892u does not teach certain elements and provided no reasoning or rationale as to why these limitations are not taught as noted in the previous action. Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

**Regarding claims 6 and 16**, Applicant contests on page 9 that 892v teaches away from the present invention by requiring registration of both buyers and sellers. The Examiner notes that the disclosure of 892u does not criticize, discredit, or otherwise discourage (i.e. teach away from) the use of 892v. 892v provides adequate motivation in the cited paragraphs as noted in the previous office action.

The additional arguments made with respect to 892v, Centner, and Herr on pages 9-11 parallel the reasons as noted under claims 1 and 11 above. For at least the reasons above, these arguments are not persuasive.

***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. **Claims 11-20 are rejected under 35 U.S.C. 101.**

Claims directed to computer-related inventions that are clearly nonstatutory fall into the same general categories as nonstatutory claims in other arts, namely natural phenomena such as magnetism, and abstract ideas or laws of nature which constitute "descriptive material." Abstract ideas, *Warmerdam*, 33 F.3d at 1360, 31 USPQ2d at 1759, or the mere manipulation of abstract ideas, *Schrader*, 22 F.3d at 292-93, 30 USPQ2d at 1457-58, are not patentable. Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." *The New IEEE Standard Dictionary of Electrical and Electronics Terms* 308 (5th ed. 1993).) "Nonfunctional descriptive material" includes but is not limited to music, literary works and a compilation or mere arrangement of data.

Additionally, both types of "descriptive material" are nonstatutory when claimed as descriptive material per se. *Warmerdam*, 33 F.3d at 1360, 31 USPQ2d at 1759.

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When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. See MPEP 2106, *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983).

The Examiner notes that in independent claim 11, the preamble recites "An electronic publication for publishing a buyer's requirements". This claim is thereby directed to "an electronic publication", which is simply a compilation or mere arrangement of data. The "electronic publication" in itself has no structural interrelation nor does it impart functionality to the invention, and is therefor considered to be data per se and is nonfunctional descriptive material.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. **Claims 1-3, 5, 8-9, 11-13, 15, 18, and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by PTO 892 reference U (herein referred to as 892u).**

**Regarding claim 1, 892u teaches:**

*categorizing the buyer's requirements into categories that are easily recognizable to the vendors, wherein each category includes one or more items required by the buyer, and further wherein an item is a product or service required by the buyer (see at least: Page 1); The Examiner notes that a buyer's request is categorized into multiple main categories (see A, B, and C) with associated subcategories (see a, b, c, d, e, f, g, h, i, j, k, and l);*

*electronically publishing the buyer's requirements, wherein each item within the categories includes a name, a description, a contact person and one or more relevant dates, wherein a name of the contact person is presented as a hyperlink to an e-mail account of the contact person (see at least: Pages 2-11); The Examiner notes that the electronic publication includes a user name of the contact person (which is the hyperlinked email address of the user; see AA pages 7 and 8) , a relevant date (see BB pages 7 and 8), and a description (see CC pages 7 and 8);*



*posting all forms and information necessary for the vendors to conduct business with the buyer, including requests for information, quotes and proposals, in a format that allows editing of the forms by the vendors and submission of an edited form to the buyer electronically* (see at least: Pages 7-9); The Examiner notes that all the information that that is necessary is posted in the listing. Those listings include requests for information, quotes, proposals, etc. (see Pages 1, 7, and 8; Pages 7 and 8 show a request for a proposal). The hyperlinked user name is posted at the top of the page and provides the respondent/vendor to the only form necessary to conduct business with the buyer (see Page 9). The email form allows for data entry into fields E and F (i.e. the email form *allows editing of the forms by the vendors and submission of an edited form to the buyer electronically*).

*creating a registration section that allows the vendors to register with the buyer, wherein after registration the vendors can receive electronic notifications concerning any item specified by the vendors during registration* (see at least: Pages 7-9); The Examiner notes that by submitting a response to the buyer, the respondent/vendor registers with the buyer. Subsequently, vendors can receive electronic notifications concerning any item specified by the vendors during registration via reply emails.

*wherein the buyer's requirements, the forms and information necessary to conduct business with the buyer, and the registration section are included in the electronic publication* (see at least: Pages 7-9).

**Regarding claim 2,** 892u teaches *updating the description of an item and the forms necessary for the vendors, by the buyer at any time* (see at least: Pages 14-G and 15-H).

**Regarding claim 3,** 892u teaches *posting to the publication drawings, figures, and pictures for viewing an possible downloading by the vendors, wherein the drawings, figures and pictures aid in conveying the buyer's requirements to the vendors* (see at least: Page 16-K).

**Regarding claim 5,** 892u teaches *wherein the electronic notification received by vendors that registered with the buyer comprises an e-mail message, an instant message, a text message, or a facsimile* (see at least: Pages 7-9). The Examiner notes that communication is facilitated by email.

**Regarding claims 8 and 9,** 892u teaches:

(8) *wherein the buyer is able to add and delete information and pages to the electronic publication at any time* (see at least: Pages 14-I, 15-J to 16-J, 16-L to 17-L, and 21-M). The Examiner notes that a buyer can add or delete any information in a posting. Additionally, the buyer may add/delete pages to the electronic publication using HTML or URLs.

(9) *wherein a single category or an individual item comprise multiple pages within the publication and the buyer is able to specify the order in which the pages are*

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*presented for viewing* (see at least: Pages 14-I, 15-J to 16-J, 16-L to 17-L, and 21-M).

The Examiner notes that by incorporating URLs the publication comprises multiple pages. Additionally, it is determined by the user the order in which those URLs are displayed in the posting to the viewer (i.e. the user *is able to* specify the order).

**Regarding claims 11-13, 15, 18, and 19**, the limitations set forth in claims 11-13, 15, 18, and 19 closely parallel the limitations of claims 1-3, 5, 8, and 9. Claims 11-13, 15, 18, and 19 are thereby rejected under the same rationale.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 4 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over 892u.**

**Regarding claims 4 and 14,** 892u teaches all of the above and further teaches wherein one of the categories is *services* (see at least: Page 1-C). 892u, however, does not teach the categories *construction and supplies*. Though 892u does not expressly show the categories *construction and supplies*, these differences are only found in the nonfunctional data regarding the naming of the various categories. The specific type of category is not functionally related to the substrate of the article of manufacture, thereby, this is descriptive material and does not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention include any category in the article of manufacture as shown by 892u because such data does not functionally relate to the substrate of the article of manufacture and merely labeling the categories differently from that in the prior art would have been obvious. See *In re Gulack* cited above.

**7. Claims 6 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over 892u in view PTO 892 reference v (herein referred to as 892v).**

**Regarding claims 6 and 16,** 892u teaches all of the above as noted and further teaches registering with the buyer by sending the buyer an email that includes a reply email address (see at least: Pages 7-9). 892u, however, does not expressly teach the vendor providing *preferred contact method wherein the preferred contact method is used to send a confirmation message to the vendors confirming successful registration*. 892v teaches a vendor *preferred contact method wherein the preferred contact method is used to send a confirmation message to the vendors confirming successful registration* (see at least: Paragraphs 11 and 27). The Examiner notes that 892v teaches buyers/requestors as well as vendors registering with the online service (see at least: Paragraphs 12-24). Additionally, all users of the service (which thereby includes buyers and vendors) must register with the service (see at least: Paragraph 27). In registering the user provides an email address (i.e. preferred contact) to which a confirmation email is sent. This confirmation email verifies the successful registration and allows the user to activate the newly registered account. It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of 892u to have included *preferred contact method wherein the preferred contact method is used to send a confirmation message to the vendors confirming successful registration* as taught by 892v in order to provide a convenient way of buyers and sellers to have a meeting of the minds (see at least: 892v, Paragraph 30).

**8. Claims 7 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over 892u in view of Centner et al . (US 2002/0007324, herein referred to as Centner).**

**Regarding claims 7 and 17,** 892u teaches all of the above as noted but does not expressly teach *creating an administration section that allows the buyer to organize information relating to the vendors, including the creation of mailing lists that are used to send electronic notifications to the vendors, wherein access to the administration is restricted to the buyer*. Centner teaches *creating an administration section that allows the buyer to organize information relating to the vendors, including the creation of mailing lists that are used to send electronic notifications to the vendors, wherein access to the administration is restricted to the buyer* (see at least: abstract, 0042). It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of 892u to have included *creating an administration section that allows the buyer to organize information relating to the vendors, including the creation of mailing lists that are used to send electronic notifications to the vendors, wherein access to the administration is restricted to the buyer* as taught by Centner in order to provide efficient distribution of a buyer's request-for-quotations to an audience of that buyer's preferred suppliers (see at least: Centner, abstract).

**9. Claims 10 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over 892u in view of Herr-Hoyman et al. (US 5,727,156, herein referred to as Herr).**

**Regarding claims 10 and 20,** 892u teaches all of the above and further teaches providing a home page (i.e. the initial posting page) and multiple other pages within the publication (i.e. linked pages) (see at least: Pages 14-I, 15-J to 16-J, 16-L to 17-L, and 21-M). 892u, however, does not expressly teach where *all of the other pages include a link that will return the vendors to the home page*. Herr teaches where *all of the other pages include a link that will return the vendors to the home page* (see at least: col. 2 lines 22-42). It would have been obvious to one of ordinary skill in the art at the time of invention to have included where *all of the other pages include a link that will return the vendors to the home page* as taught by Herr in order to provide an easy means of returning to the main page of the listing without having to manually navigate back through the multiple other pages.

***Conclusion***

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William J. Allen whose telephone number is (571) 272-1443. The examiner can normally be reached on 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff A. Smith can be reached on (571) 272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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William J. Allen  
Patent Examiner  
September 14, 2006



JEFFREY A. SMITH  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600